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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,127	11/08/2006	Stephan Haser	100341.56596US	4068

23911 7590 06/07/2010  
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EXAMINER
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GEBRESILASSIE, KIBROM K

ART UNIT	PAPER NUMBER
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2128

MAIL DATE	DELIVERY MODE
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06/07/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,127	<b>Applicant(s)</b> HASER ET AL.	
	<b>Examiner</b> KIBROM GEBRESILASSIE	<b>Art Unit</b> 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/28/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This communication is responsive to RCE filed on 04/20/2010.
2. Claims 3-5 are presented for examination.

### *Response to Arguments*

3. Applicant's amendment relating to Claim Objection is considered and therefore the objection is **withdrawn**.

4. Applicant's amendment/argument relating to 112 rejection is considered.

However, note a new 112 rejection.

5. Applicant's argument relating to art rejection is not persuasive.
  - a. Applicant argued that the prior art of reference fails to disclose "creating starting design based from the basic design".

Examiner respectfully disagrees. Kitani et al discloses predetermined specific power is determined and design related data is designated as design input (i.e. basic design), on the basis of this input data, the spherical form of the lens is determined, and the optical characteristics of that lens are computed (i.e. starting design) (See: Col. 13 lines 13-17), which is analogous to the above limitation.

- b. Applicant's argued that the prior art of reference fails to disclose "calculate individual progressive lenses for wearing tests from the starting design".

Examiner respectfully disagrees. Kitani et al discloses "while performing lens portion specification (distance portion, near portion etc) (i.e. starting design) and optical quantity specification (surface and transmission astigmatism, average

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refractive power error, etc) particularly as design factors, an optimization calculation in optimization (i.e. calculating), on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form (i.e. wearing test ( See: Col. 13 lines 56-59), which is analogous to the above limitation.

c. Applicant's argued that the prior art of reference fails to disclose "create final starting design for production from the adjusted starting design".

Examiner respectfully disagrees. Kitani et al discloses "processing data is created on the basis of a previously created lens progressing program for the progressive power lens, then at the plant (i.e. production), the process specification (i.e. final design) document is used as basis for selecting a lens (See: Col. 16 lines 34-51).

d. Applicants argued that a prima facie case of obviousness is not presented in this record.

As indicated in the previous Office Action, Kitani et al does not expressly disclose adjusting of the starting designs on the basis of the wearing tests.

Yamakaji et al discloses adjusting of the starting designs on the basis of the wearing tests (such as "VC value can be adjusted to a certain prescribed value (for example, a value determined by an optician) (i.e. wearing tests)"; See: Col. 5 lines 51-58).

It would have been obvious to one of ordinary skill in the art to combine the teaching of Yamakaji et al with the teaching of Kitani et al because both

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references drawn to design process of progressive power lenses. The motivation to include the teaching of Yamakaji et al such as adjusting of the designs on the basis of the wearing tests to the system of Kitani et al would be to determine the conditions of corrective prescriptions.

e. Further, Kitani et al discloses the new amended subject matters as follows:

the starting designs for wearing tests comprising at least one series of progressive lenses for myopia, one series of progressive lenses for emmetropia and one series of progressive lenses for hyperopia (such as "showing focal points for reference power corresponding to distance vision (i.e. for hyperopia), intermediate vision (i.e. for emmetropia) and near vision (i.e. for myopia", See: Col. 8 lines 64-66), one series of progressive lenses comprising at least two progressive lenses with differing addition (such as "the difference between the measured values from the convex face of the lens at distance reference point 2 and near reference point 4 is addition"; See: Col. 7 lines 50-54).

***Claim Rejections – 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- It is unclear what does it mean by "test subjects person" (line 12)?

- It recites "the individual progressive lenses for wearing tests corresponding to individual data for wearing of test subjects person who are to wear eye glasses with said individual progressive lenses" (lines 11-13). The whole recited limitation is indefinite and vague. It is unclear what does it mean.
- It recites "adjusting of the starting design for wearing tests on the basis of the wearing tests" (line 14). Does the "adjusting" based on the starting design created by the basic design step or the calculation of individual progressive lens for wearing tests from the starting design step? For this reason, there is insufficient antecedent basis for this limitation in the claim.

### ***Claim Interpretation***

8. Claim 3 recites "the starting designs for the production having more options than the starting design for the wearing tests". The claimed language recited is just an intended use. This limitation is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6, 712, 467 issued to Kitani et al in view of US Patent No. 6, 637, 880 issued to Yamakaji et al.

f. As per Claims 1 and 2, (Canceled).

g. As per Claims 3, Kitani et al discloses method for calculating an individual progressive lens for a customer, comprising:

Creating a basic design for lenses based on theoretical specifications, wherein the basic designs is calculated for a given lens power and for default values for individual parameters (such as "predetermined specific power is determined and design related data is designated as design input, on the basis of this input data, the spherical form of the lens is determined, and the optical characteristics of that lens are computed"; See: Col. 13 lines 13-17);

creating starting designs for wearing tests from the basic design (such as "predetermined specific power is determined and design related data is designated as design input, on the basis of this input data, the spherical form of the lens is determined, and the optical characteristics of that lens are computed"; See: Col. 13 lines 13-17);

calculating individual progressive lenses for wearing tests from the starting designs for wearing tests, the individual progressive lenses for wearing tests corresponding to individual data test of test subjects persons who are to wear eye-glasses with said individual progressive lenses (such as "in optimization (i.e.

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calculating), on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form (i.e. wearing test)"; See: Col. 13 lines 56-59), and

creating final starting designs for production from the adjusted starting designs (such as "the final lens face forms and lens thickness are determined, a prescribed progressive power lens is determined, once the order for a progressive power lens of the aforementioned prescription has been made, processing data is created, this processing data is created on the basis of previously created lens processing program for the progressive power lens"; See: Col. 16 lines 22-36); and

calculating individual progressive lens for the customer from the final starting designs according to individual data (such as "in optimization (i.e. calculating), on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form (i.e. wearing test)"; See: Col. 13 lines 56-59),

said starting designs for wearing tests and the starting designs for production being a limited number of progressive lenses, which are calculated for default values of the individual parameters and which cover a predetermined range of powers of the lens (such as "in optimization (i.e. calculating), on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form (i.e. wearing test)"; See: Col. 13 lines 56-59),



the starting designs for wearing tests comprising at least one series of progressive lenses for myopia, one series of progressive lenses for emmetropia and one series of progressive lenses for hyperopia (such as "showing focal points for reference power corresponding to distance vision (i.e. for hyperopia), intermediate vision (i.e. for emmetropia) and near vision (i.e. for myopia", See: Col. 8 lines 64-66), one series of progressive lenses comprising at least two progressive lenses with differing addition (such as "the difference between the measured values from the convex face of the lens at distance reference point 2 and near reference point 4 is addition"; See: Col. 7 lines 50-54), and

the starting designs for the production having more options than the starting design for the wearing tests (i.e. an intended use).

Kitani et al does not expressly disclose adjusting of the starting designs on the basis of the wearing tests.

Yamakaji et al discloses adjusting of the starting designs on the basis of the wearing tests (such as "VC value can be adjusted to a certain prescribed value (for example, a value determined by an optician) (i.e. wearing tests)"; See: Col. 5 lines 51-58).

It would have been obvious to one of ordinary skill in the art to combine the teaching of Yamakaji et al with the teaching of Kitani et al because both references drawn to design process of progressive power lenses. The motivation to include the teaching of Yamakaji et al such as adjusting of the designs on the

basis of the wearing tests to the system of Kitani et al would be to determine the conditions of corrective prescriptions.

***Allowable Subject Matter***

11. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art on the record, in combination or alone, suggests or discloses the limitations as recited, arranged in claim 4 and as defined in the specification.

13. Claim 5 is objected as being dependent upon claim 4.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIBROM GEBRESILASSIE whose telephone number is (571)272-8571. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571)272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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